



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/781,973

02/18/2004

Ilya Ostrovsky

DNAG-278 (10402028)

1039

24972 7590 04/05/2007

FULBRIGHT & JAWORSKI, LLP

666 FIFTH AVE

NEW YORK, NY 10103-3198

EXAMINER

LEADER, WILLIAM T

ART UNIT

PAPER NUMBER

1742

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
|--|-----------|---------------|

3 MONTHS

04/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/781,973 | Applicant(s) OSTROVSKY, ILYA | |
| | Examiner William T. Leader | Art Unit 1742 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 and 43-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/19/2005; 2/16/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 32-42 in the reply filed on January 10, 2007 is acknowledged. Applicant has also elected an alcohol having at least one alkaline radical group as the species to be examined. The traversal is on the ground(s) that the Examiner has not provided any reason why one would dip a substrate into the bath of the group I claims. This is not found persuasive because the dipping would produce a coating of bath solution on the article which could be dried to form a phosphate-containing coating.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 32-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (6,916,414) in view of Schaedel (4,152,221).

4. The Dolan patent is directed to a process for anodizing light metals such as aluminum and magnesium (column 1, lines 15-16). The process includes the steps of providing the light metal article, placing the article as an anode in an anodizing solution, providing a cathode electrode in the solution and passing an electric current between the article and the cathode

electrode. See column 2, lines 46-56. These steps correspond to the process steps recited in instant claims 32-35. The anodizing solution may comprise a water-soluble phosphorus oxysalt, water-soluble alkali metal hydroxides (column 2, lines 25-45). In one embodiment, the solution contains a phosphate, a soluble amine such as an alkanolamine. The pH of the anodizing solution is neutral to basic, preferably about 7.1 to 12. See column 4, line 63 to column 5, line 27). Thus, Dolan teaches all constituents of the bath recited in instant claims 32-35 except for a surfactant. With this solution, the generation of a sustained plasma (visible light emitting discharge) during anodization may be attained using a pulsed DC voltage in some instances of no more than 80 volts. See column 5, lines 28-35.

5. As noted above, claim 32 differs from the process of Dolan by reciting the inclusion of at least one surfactant. The Schaedel patent is directed to an anodizing process. Schaedel teaches the inclusion of a surfactant in the anodizing solution to form an oxygen holding foam around the part being anodized. See the abstract. The prior art of record is indicative of the level of skill of one of ordinary skill in the art. It would have been obvious at the time the invention was made to have included a surfactant in the anodizing solution of Dolan as taught by Schaedel because the solution would have made better contact with the article being anodized.

6. With respect to claim 36, Dolan discloses that direct current is preferably used, although alternating current may also be used (column 4, lines 7-11). As indicated above, Dolan teaches that the article is made the anode. With respect to claim 37, Dolan discloses that the article is subjected to a cleaning and/or degreasing step before being subjected to anodic treatment (column 9, lines 26-28). With respect to claim 38, Dolan discloses that after cleaning the article

is preferably rinsed with water (column 9, lines 33-34). With respect to claim 39, current density is a result-effective variable. Choice of an appropriate current density to achieve a desirable anodized coating would have been a matter of routine optimization in accordance with the teaching of Dolan. With respect to claim 40, Dolan discloses that the anodizing solution is preferably maintained at a temperature between about 5 and 90 °C. This range significantly overlaps that recited by applicant. Choice of values from within the range disclosed by Dolan would have been obvious. With respect to claim 41 in examples 1-4, Dolan discloses that the rate of film deposition was approximately 10-15 microns per minute, and that current was applied for approximately 2 minutes. This would give a thickness of 20-30 microns. In example 5, a coating of 2.5 microns was produced. These values fall within the range recited by applicant. Instant claim 42 recites an additional coating. Dolan discloses that the protective coatings produced on the surface of the light metal article may, after anodization, be subjected to further treatments such as painting, sealing, and the like. Claim 42 contains the expression "e.g.". This expression is interpreted to mean for example. The subject matter appearing after "e.g." is considered to be exemplary but not limiting.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Art Unit: 1742

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 32-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 66,875,334 in view of Kinase et al (4,416,742). Claim 1 of the '334 patent recites a process for anodizing using a solution which contains hydroxylamine, phosphate anions, a nonionic surfactant, and an alkali metal hydroxide. The solution used in the method of the instant claims contains an alcohol showing at least one alkaline radical group. Triethanolamine is an alcohol falling within the scope of this limitation. Kinase et al discloses that both triethanolamine and hydroxylamine are recognized additives for use in coating baths. It would have been obvious to have utilized triethanolamine in place of the hydroxylamine recited in the claims of the '334 patent because Kinase et al shows them to be equivalent additives.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245.

The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

Art Unit: 1742

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


William Leader
April 2, 2007


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700